

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 13, 14, 16, 17, and 18-27 are rejected under 35 U.S.C. 102(b) over the patent to Savage.

Claim 16, 17, 19 and 20 are also objected.

After carefully considering the Examiner's grounds for objection to some claims, the corresponding claims have been amended. It is believed that the grounds for the formal objections to the claims should be considered as no longer tenable and should be withdrawn.

In connection with the Examiner's rejection of the claims over the patent to Savage, the claims currently on file has been retained as they were.

It is respectfully submitted that the new features of the present invention which are defined in the current claims can not be considered as

disclosed in the patent to Savage or derived from it as a matter of obviousness.

The reasons why the patent to Savage can not anticipate or make obvious the present invention as defined in the claims were presented in the previous Amendment. In addition, applicants wishes to make the following remarks. It is not acceptable to consider the elements 42 and 28 of the patent to Savage as a slaving element as defined in the claims currently on file.

When the Examiner assembled several elements in order to supposedly find the spring element of the present invention in the prior art, he used such unpermissible argumentation in order to compose a slaving element of diverse components. As can be clearly seen from the disclosure of the present application and in particular the advantages of the device of the present invention, the device in accordance with the present invention provides only one-piece element. It can not be considered as obvious and it is not explained by the Examiner why the components 42 and 28 must form a slaving element.

The component 42 is a nut which is screwed on the shaft. A connection between the components 42 and 28 is not available. The question is therefore why the component 42 must belong to the component 28. These components, both with respect to their design and also their functions, are separate components which are different from a slaving element, and therefore their identification with the slaving element is false and not permissible.

The Examiner's interpretation of the reference to make the device disclosed in the reference look similar to the device of the applicant's invention is really a hindsight consideration provided by the Examiner with respect to the patent to Savage, which is not permissible for examination purposes.

As was stated in the decision *W. L. Gore & Associates, Inc. V. Garlock, Inc.*, disclosed in 220 USPQ 303, 312-13 (Fed. Cir. 1983):

To imbue one of ordinary skill in the art with knowledge of an invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to small victim of the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher".

It is believed that this decision is applicable for the Examiner's argumentation in the Office Action.

Contrary to the Examiner's opinion, the spring element 46 of the device disclosed in the patent to Savage is not arranged between the slaving element 24 and the add-on part 22. Instead, as can be seen from Figure 1 of the patent to Savage and the associated description, it is located between the nut 42 and the add-on part 22.

It is believed to be clear that the disclosure of the patent to Savage can not anticipate the new features of the present invention. In connection with this, the reference is made to column 2, line 64 to column 3, line 11 of the patent to Savage.

In the device of the applicant's invention the inventive design of a slaving element 14 makes the use of a screw 42 arranged additionally on the axle completely superfluous. Therefore the teaching which a person of ordinary skill in the art can obtain from the patent to Savage leads away from the applicant's invention and can not anticipate the applicant's invention in any way. The Examiner, in unpermissible manner assembled several separate or in other words functionally different components, to obtain the

function of the device in accordance with the present invention. This argumentation is not acceptable. The Examiner's attention is respectfully directed to the fact that Figure 1 of the patent to Savage clearly shows that the spring element 46 is not directly clamped not between the slaving element and the add-on part, but instead between the add-on element 14a and a shoulder 48 or 50 of the counter nut 42.

A further argument why the patent to Savage can not anticipate the new features of the present invention is as follows: the slaving element 14 defined in the claims is seated in a manner fixed against rotation on the drive shaft 12 and transmits a rotary motion from the drive shaft 12 to the add-on part 10.

If the nut 42 of the device disclosed in the patent to Savage belongs to the slaving element, which interpretation is completely unjustifiable, then the slaving element is not mounted on the shaft in a manner fixed against relative rotation. As can be clearly seen from the patent to Savage the nut 42 is screwed on the end of the shaft. This is disclosed in column 2, line 64, to column 3, line 11 of the patent to Savage. The slaving element which is constructed by the Examiner from the components 42 and 28 is thereby, in contrast to the slaving element defined

In the claims, not arranged on the shaft in a manner fixed against relative rotation. Therefore it is believed that this feature is also new with respect to the device disclosed in the patent to Savage.

Moreover, the slaving element of the device in accordance with the present invention transmits a rotary motion from the drive shaft to the add-on part. It is believed to be clear that the nut 42 of the patent to Savage can not be identified with a slaving element, or perceived as a part of a slaving element. The nut 42 of the device disclosed in the patent to Savage does not transmit any rotary motion to the add-on part.

If the Examiner based on his unpermissible hindsight insists that the components 42 and 28 represent a slaving element, then the slaving element does not correspond to the slaving element of the applicant's invention.

The Examiner rejected the claims as being anticipated by the patent to Savage. In connection with this, it is believed to be advisable to cite the decision in *re Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Savage does not disclose each and every element which are now defined in the independent claims, and therefore the anticipation rejection should be considered as not tenable and should be withdrawn.

It was also explained herein above that the present invention can not be derived from the patent to Savage as a matter of obviousness. In order to arrive at the applicant's invention from the teaching of the patent to Savage, the device disclosed in the patent to Savage has to be fundamentally modified. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to

modify its structure to one which prior art references do not suggest.

Definitely, the patent to Savage does not provide any hint or suggestion for such modifications.

Finally, as explained herein above, the device of the present invention provides for the highly advantageous results which can not be accomplished by the construction of the device disclosed in the patent to Savage.

It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.


In view of the above presented remarks and amendments, it is believed that the independent claims currently on file should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 13, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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